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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/368,076 08/03/99 JIN

H 7682-047

EXAMINER

HM12/1213

PENNIE & EDMONDS LLP
1667 K STREET NW
WASHINGTON DC 20006

BRUMBACK, B

ART UNIT

PAPER NUMBER

1642

8

DATE MAILED:

12/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/368,076

Applicant(s)

Hong et al.

Examiner

Brenda Brumback

Group Art Unit

1642



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-35 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-35 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1642

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to isolated respiratory syncytial virus (RSV) with an M2-2, SH, NS1, or NS2 gene mutation classified in class 435, subclass 236.
 - II. Claim 13, drawn to isolated RSV with an M2-1 gene mutation, classified in class 435, subclass 236.
 - III. Claims 14 and 15, drawn to RSV comprising a heterologous sequence from another strain of RSV, classified in class 435, subclass 172.3.
 - IV. Claims 14 and 16, drawn to RSV comprising a heterologous sequence derived from a virus other than RSV, classified in class 435, subclass 175.3.
 - V. Claims 17, 19-21, and 35 drawn to vaccines comprising RSV mRNA with a mutation or deletion of the M2-1 gene, classified in class 424, subclass 205.1 or 211.1.
 - VI. Claims 17, 18, 22-32, and 35, drawn to vaccines comprising RSV mRNA with M2-2, SH, NS1 or NS2 gene mutations or deletions, classified in class 424, subclass 205.1 or 211.1.

Art Unit: 1642

VII. Claims 33 and 34, drawn to vaccines comprising RSV mRNA and a heterologous sequence, classified in class 424, subclass 199.1.

Note: Claims which appear in more than a single group will be examined to the extent that they read on the elected group.

2. Inventions I-IV and V-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the RSV of Groups I-IV can be used in the materially different processes of diagnostic testing and affinity purification of antibodies.

The viruses of Inventions I-IV have different structures and different characteristics. The vaccine compositions of Inventions V-VII also have component viruses with different structures and different characteristics.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 1642

4. Claims 33 and 34 are generic to a plurality of disclosed patentably distinct species comprising RSV mRNA with M2-1, M2-2, SH, NS-1, or NS-2 mutations or deletions with a heterologous sequence. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1642

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Brumback whose telephone number is (703) 306-3220. If the examiner can not be reached, inquiries can be directed to Supervisory Patent Examiner Anthony Caputa whose telephone number is (703) 308-3995. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Examiner Brenda Brumback, Art Unit 1642 and should be marked "OFFICIAL" for entry into prosecution history or "DRAFT" for consideration by the examiner without entry. The Art Unit 1642 FAX telephone number is (703)-305-3014. FAX machines will be available to receive transmissions 24 hours a day. In compliance with 1096 OG 30, the filing date accorded to each OFFICIAL fax transmission will be determined by the FAX machine's stamped date found on the last page of the transmission, unless that date is a Saturday, Sunday or Federal Holiday with the District of Columbia, in which case the OFFICIAL date of receipt will be the next business day.

BB

December 12, 2000

Brenda Brumback
Brenda Brumback,
Patent Examiner